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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,152	10/06/2000	Sean Hu	PSTM0034/MRK	9961

29524 7590 02/10/2005

KHORSANDI PATENT LAW GROUP, A.L.C.  
140 S. LAKE., SUITE 312  
PASADENA, CA 91101-4710

EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/684,152

Applicant(s)

HU ET AL.

Examiner

Jamisue A. Webb

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 5-24 and 26-55 is/are pending in the application.
- 4a) Of the above claim(s) 21-24, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-20, 26-35 and 38-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20041122, 20041119</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to amendment filed 11/9/04.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 42 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. With respect to Claims 42 and 48: the phrase "wherein said test image information corresponds to whether said test image was displayed on a predetermined number of lines on said display device" is indefinite. It is unclear to the examiner what this phrase is trying to actually claim. Does this have to do with the size of the display? What does it mean by lines?

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 5-20, 26-35, 38-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (6,233,568) in view of Martin et al. (6,078,936).

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7. With respect to Claims 5-8, 10-12, 14-18, 26-33, 35, and 38-55: Kara discloses the use of a Shipping Management Computer System (see abstract) that is programmed to recognize a set of graphic resolution characteristics of a printer device (See Figure 6 and column 4, lines 49-54). Kara discloses the computer system used to create and generate a shipping label image bearing a dimensionally accurate symbology for display (See Figure 9). Kara also discloses the step of generating a shipping label according to a set of rules for a particular service of a particular carrier and according to the selection of the user (see Figures 6-9 and column 5, lines 43-47, column 6, lines 22-32). Kara discloses the users having a remote communication link such as the internet (See Claim 45), the examiner considers this to be global communication link, since the internet can be accessed at any location across the globe. It is also the examiner's position that the system is for multiple users, therefore would have multiple printer devices.

8. Kara discloses the use of displaying the shipping label before printing, but fails to specifically disclose the display being electronically formatted for a particular printing device, where the system recognized the graphic resolution characteristics of the shipping device for printing. Martin discloses the use of a display with a resolution to display images being dimensionally accurate, and to display the image as it would appear on an output device such as a printer (see abstract, Column 9, lines 43-55, column 10, lines 16-23, and Column 14, lines 11-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Kara, to have the display image of the shipping label, appear on a display the same as it would appear on a printing device, as disclosed by Martin, in order to provide a visualization of how a specific output device such as a printer, would present an image, in order

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to view the printed matter substantially the same as it would be printed out on an output device (See Martin, Columns 2-4).

9. With respect to Claims 8, 18 and 33: See Kara, Figures 8 and 9 with corresponding detailed descriptions, and Column 6, lines 22-39.

10. With respect to Claims 9, 10, 19, 20, 34 and 35: See Kara, Reference numeral 710 and column 19 line 66 to column 20, line 61.

11. With respect to Claims 13: Kara and Martin, as disclosed above for Claim 5, discloses the use of a printing device which can be a printer that is currently used by a computer system, and discloses the display to be representative of the particular printing device, but fails to specifically disclose using a laser printer.

12. At the time the invention was made, it would be been an obvious matter of design choice to a person of ordinary skill in the art to use a laser printer for generating the shipping labels because Applicant has not disclosed that using a laser printer provides an advantage, is used for a particular purpose or solves any stated problem. One of ordinary skill in the art furthermore, would have expected Applicant's invention to perform equally well with any printer whether it be a laser printer or an ink jet printer because they both provide the overall result of generating a shipping label.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 5-35 have been considered but are moot in view of the new ground(s) of rejection.

14. With respect to Applicant's arguments with regards to the design choice of using a laser printer: The applicant has argued that the specification does provide an advantage and is used for a particular purpose. However, the specification merely teaches away from specific shipping label printers and gives reasons as to why these should not be used. The specification states why a general printer, that would be used for all other purposes, should be used, but never specifically states why it should be a laser printer, other than the fact stating that is a multi-purpose printer that is commonly used, and would not require a specific printer for printing only shipping labels or barcodes. Kara discloses that the shipping labels can be printed from any general purpose printer, and discloses the printer does not have to be a specific printer for shipping labels. Martin discloses the display being presented according to the printer characteristics, and discloses the use of general printers. Therefore, whether the multi-purpose printers of Kara and Martin, do not specifically state that they are laser printers, they do state they can be general printers used for other things. Which is the reasoning in the specification for using a laser printer. Therefore the examiner still considers the specific use of a laser printer is a design choice, over any other general multi-purpose printer.

### *Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

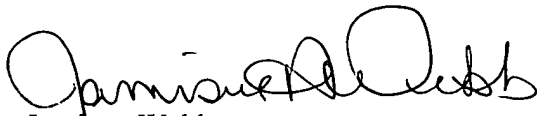
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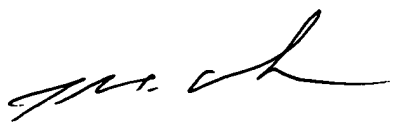
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jamisue Webb

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3500